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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,031	04/05/2001	Edward J. Boyle	40655.1000	4847

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EXAMINER
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HARBECK, TIMOTHY M

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/827,031	<b>Applicant(s)</b> BOYLE ET AL.	
	<b>Examiner</b> Timothy M. Harbeck	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-30, 32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-30 and 32-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-30 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoham et al (hereinafter Shoham US PAT 6,584,451 B1) in view of Halbert et al (hereinafter Halbert US PAT 6,101,484) in view of Bi et al (hereinafter Bi, US PAT 6,311,178 B1) in view of Walker (US Pat No. 5,794,207).

**Re Claim 21:** Shoham discloses a computer implemented method for facilitating an auction (Column 3, lines 29-31) comprising a consumer defined purchase rule for a selected item (Column 6, lines 52-57, 62-67), retrieving a subset of consumer information wherein said subset comprises consumer information having a similar said consumer defined purchase rule (Column 5, lines 16-17). This is the main motivation behind the Shoham invention; to aggregate the buying power of small volume buyers to promote competition among vendors.

Shoham further discloses providing said subset to a vendor offering said item (Column 2, lines 63-65) and accepting a bid for said vendor to provide said item to said subset (Column 3, lines 5-6). While not specifically disclosing that the bid is "accepted," the motivation behind an auction system is for goods to be exchanged between a buyer and a seller. This could not occur unless a bid is accepted. Furthermore, the disclosure

Art Unit: 3628

of Shoham reads "the seller(s) then sell the goods to all buyers who offered more than the discovered price, (Column 3, lines 5-6)" which leads to the conclusion that a bid was accepted and that acceptance of this offer implies that the vendor was in fact able to accommodate the buyers within the previously defined consumer thresholds.

Shoham further discloses verifying that said bid is in accordance with said consumer defined purchase rule (Column 3, lines 1-5). The fact that the facilitator accepts a bid from a seller leads to the conclusion that the consumer defined purchase rule is met and that the vendor has the ability to accommodate this rule, or else the submission of said consumer defined purchase rule would be moot.

Shoham discloses confirming that said bid is optimum (Column 4, lines 28-40), based on different criteria.

Shoham does not explicitly disclose that the consumer defined purchase rules are stored in a database. Halbert discloses a dynamic market equilibrium management system that is adapted for the sale of goods and services through an online buying group formed for the specific purpose of purchasing a particular product. According to the disclosure, for a potential buyer to join the purchasing group, he or she must determine the price at which he or she is willing to purchase the featured item. Halbert then proceeds to read that all offers including the various amounts at which they are submitted are collected and summarized in a database (Column 3, lines 4-10). It would have been obvious to someone skilled in the ordinary art at the time of invention to modify the method of Shoham to include the database of Halbert, so that the facilitator for aggregate buying would have a reference of all consumer purchase rules submitted.

The facilitator would then be able to compile lists of consumers with compatible purchase rules and present them to a vendor and thus maximize the leverage associated with aggregate purchasing.

Shoham also does not explicitly disclose the step wherein there are multiple consumer defined purchase rules for the same buyer. Bi discloses a multi element confidence matching system and the method therefor wherein a consumer can include multiple elements for an offer to purchase a commodity that must be matched with an appropriate counter party before the deal is executed (See abstract). It would have been obvious to anyone skilled in the ordinary art at the time of invention to include this feature to the disclosure of Shoham because in many transactions there are a variety of parameters that could affect ones overall satisfaction in terms of completing a deal. If the consumer is allowed to enter multiple search criteria than they can be assured that any match returned by the system will be as optimal as possible.

Shoham / Halbert / Bi does not explicitly disclose wherein said database is a travel reservation database and wherein said item is an itinerary from a travel service. Walker teaches a method to facilitate buyer driven conditional purchase offers that references the purchase of airline tickets as a potential use for the method (Column 8, line 49-56). It would have been obvious to someone of ordinary skill in the art at the time of invention to modify the method of Shoham / Halbert / Bi to include the disclosure of Walker so that participants in the Buyers club could utilize the method for travel reservations since this is a notoriously well known example of a service that is based on a dynamic price scale that is commonly reduced for group rates. A method like the one

Art Unit: 3628

disclosed by Shoham / Halbert / Bi wherein small volume buyers are aggregated to increase their bargaining leverage with a vendor would be well suited to handle these types of purchases. This follows then that said item comprises at least one of a good or service because an airline reservation satisfies this requirement.

Finally while the references do not disclose modifying the itinerary according to the bid, this is essentially just confirming the final itinerary to the customer. In Shoham, the customer lists parameters, which, if met, would satisfy their needs for the product or service. In setting these parameters the customer is setting the bounds of an acceptable agreement and therefore if the supplier can meet these demands, the agreement is consummated. In the broad case the "modifying" is simply just a narrowing from the bounds submitted by the customer, to the actual agreed upon figure. In the case of a travel reservation service, the modifying step would be from the broad itinerary listed as parameters, to the confirmed specific itinerary. Therefore it would have been obvious to modify Shoham / Halbert / Bi / Walker to include this feature so that the customer is aware of the final details of the purchase and can plan accordingly.

**Re Claim 22:** Shoham / Halbert / Bi / Walker discloses the claimed method supra, and Shoham further discloses notifying, via said travel reservations database, said consumer of said optimum bid (Column 2 line 65- Column 3 line 1).

**Re Claim 23:** Shoham / Halbert / Bi / Walker discloses the claimed method supra, and Shoham further discloses a method wherein said confirming step comprises determining if said bid provides optimum savings (Column 4, lines 31-34).

**Re Claim 24:** Shoham / Halbert / Bi / Walker discloses the claimed method supra, and Shoham further discloses a method wherein said verifying step comprises evaluating said bid based on a proposed price and a proposed provision of said travel service (Column 2 line 65- Column 3 line 5).

**Re Claim 25-26:** Shoham / Halbert / Bi / Walker discloses the claimed method supra, and Shoham further discloses a method wherein said storing step comprises storing in said travel reservations database a deviation to said rule and storing in said travel reservations database a restriction upon a deviation from said rule. Shoham reads “another alternative is to allow the buyer to submit the equivalent of a schedule: buy product A unless product B is 40 dollars less. In that case buy product B. (Column 6, lines 52-54).” In this case the buying of product B would represent a deviation from the original rule to purchase product A. The said schedule then proceeds to apply a restriction that product B must be at least 40 dollars less than product A for the facilitator to apply said deviation from the original rule.

**Re Claim 27:** Shoham / Halbert / Bi / Walker discloses the claimed method supra, and Walker further discloses said travel service comprises at least one of an airline reservation, automobile reservation, and hotel reservation and does not explicitly disclose the purchase of at least one good and service (Column 8, line 49-56).

**Re Claim 28:** Shoham / Halbert / Bi / Walker discloses the claimed method supra, and Halbert further discloses a method wherein said retrieving step comprises scanning said travel reservations database to determine individual consumers with similar consumer defined purchase rules, placing these similar individual consumers

Art Unit: 3628

into said subset (Column 3, lines 4-12). Halbert reads, "All offers including the various amounts at which they are submitted are collected and summarized in a database (Column 3, lines 8-10)." The process of summarizing the information in the database is interpreted as placing the similar entries together, as this is the main objective and motivation of the Halbert method as disclosed (Column 1, lines 18-23). While Halbert does not explicitly mention the use of "rows" in a database, it is well known in the art at the time of invention that computerized databases (i.e. Microsoft Excel), use individual rows to differentiate between individual entries in a system, and could have been easily applied in this case.

**Re Claim 29:** Shoham / Halbert / Bi / Walker discloses the claimed method supra, and Shoham further discloses a method wherein an individual row (consumer entry or request) of said rows is placed into more than one subset. Shoham discloses the use of "switching goods" (Column 5, lines 3-8) and limit orders (Column 6, lines 61-67). In switching goods, "a buyer can submit a bid for either X or Y, depending on price," which means that the consumer request can be placed into more than one particular subset of products for purchase. In a limit order, a customer may make a request to "buy product A if the price drops below \$300," which means that this particular entry could be placed within any subset of consumer requests seeking to buy product A for less than \$300 (i.e. \$295, \$275, \$250).

**Re Claim 30:** Shoham / Halbert / Bi / Walker discloses the claimed method supra, and Shoham further discloses a method wherein said rows (consumer requests) are similar when said consumer defined purchase rule differs by less than a



Art Unit: 3628

predetermined criteria. Shoham states, "The primary function of the mechanism is to automatically aggregate the buying power of these buyers (Column 1, lines 55-60)." In order for these buyers to be grouped together properly there must be some inherent defined criteria to determine orders that are similar. Combining dissimilar requests does nothing to aggregate the buying power of a group, because members of the group would want different things, and this would work directly against the motivation outlined by Shoham.

**Re Claim 32:** The further system claim would have been obvious by performing the method claim 21 rejected above and is therefore rejected using the same art and rationale of Shoham / Halbert / Bi / Walker.

**Re Claim 33:** Shoham / Halbert / Bi discloses the claimed method supra but does not explicitly disclose the step wherein said consumer defined purchase rules include at least two of price, scheduling preferences, departure airport, destination airport departure date, departure time, arrival data, arrival time, seating preference and special accommodations. Walker teaches a method to facilitate buyer driven conditional purchase offers that references the purchase of airline tickets as a potential use for the method (Column 8, line 49-56). It was well known in the art at the time of invention for a purchaser of airline tickets to have a set of rules regarding their travel, with the purchase of the tickets contingent on said rules. Each customer has different agendas and they need a way to define this agenda to the airline in order to be satisfied. It would have been obvious to anyone skilled in the ordinary art at the time of invention to include this feature to the disclosure of Shoham/ Halbert/ Bi so that a

Art Unit: 3628

customer traveling on an airline can be assured that they arrive or depart at the correct location at the correct time.

### ***Response to Arguments***

Applicant's arguments filed 4/27/2006 have been fully considered but they are not persuasive. In response to applicant's argument that "the disclosed systems would not be capable of providing beginning to end processing of an itinerary, wherein any number of external reservations systems may need to be scanned in order to group similar itineraries into subsets for the purpose of aggregating the purchasing power of travelers", the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Reserving a travel itinerary is a service with multiple parameters. In this instance the Shoham discloses a broad method for aggregating buying power for goods and services (See abstract). Bi discloses a multi element confidence matching system and the method therefor wherein a consumer can include multiple elements for an offer to purchase a commodity that must be matched with an appropriate counter party before the deal is executed (See abstract). Walker suggests utilizing a buyer driven method for aggregating purchasers of airline tickets (Column 8, line 49-56). It is the examiners contention that these two references would have suggested the aforementioned limitation to a person of ordinary skill in the art,

specifically because in many transactions there are a variety of parameters that could affect ones overall satisfaction in terms of completing a deal. If the consumer is allowed to enter multiple important parameters than they can be assured that any match returned by the system will be as optimal as possible. In stating the aforementioned passage the applicant has provided no rationale as to why the systems are not capable of performing the claimed limitation or why the examiners rationale in the previous action is erroneous.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

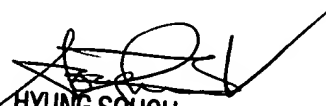
Art Unit: 3628

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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